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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Eric Allain

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EXAMINER

MARX, IRENE

ART UNIT

PAPER NUMBER

1651

NOTIFICATION DATE

DELIVERY MODE

05/05/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-NY@novozymes.com

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Note:

The proposed amendment raises new issues that would require further consideration and/or search with respect to the amendment to claim 1 to replace comprising "at least one surfactant and a glucoamylase" with "comprising at least one surfactant and a glucoamylase, wherein the surfactant comprises an alcohol ethoxylate", including issues under 35 U.S.C § 112.

Response to Arguments

Applicant's arguments as they pertain to the claims on record have been fully considered but they are not deemed to be persuasive.

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see **37 CFR 1.116**) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under **37 CFR 1.116(b)(3)** is expected in all amendments after final rejection, i.e., "An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented."

Applicant again argues that the Examples 1 and 3 of the instant application show that the use of a surfactant (SOFTANOL B 90 and BEROL 087, respectively) and a glucoamylase during fermentation results in a significantly greater ethanol yield than the use of a glucoamylase alone.

However, the claims of record are not directed to the use of the surfactants of the particular SOFTANOL B 90, TRITON X100, and/or BEROL 087 in conjunction with a glucoamylase and a cellulase during fermentation as touted. The claims are directed to the inclusion of unidentified glucoamylase and "at least one surfactant". Only in claim 42 is the surfactant an alcohol ethoxylate. Moreover, the microorganism in claim 41 is unidentified and in claim 43 it is "a yeast" which is not identified. It is noted that the use of a glucoamylase and cellulase is claimed in dependent claim 48.

Regarding the touted "surprising and unexpected results", the product sheets provided are considered to the extent argued. While each individual product constitutes an alcohol ethoxylate this does not mean that the effects of all products within this class are the same. In this regard,

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applicant fails to consider that the results reported in Example 2 suggest that the yield of ethanol obtained using glucoamylase plus the alcohol ethoxyxate TRITON X100® compared to using glucoamylase alone is virtually identical.

The scope of the showing must be commensurate with the scope of claims to consider evidence probative of unexpected results, for example. In re Dill, 202 USPQ 805 (CCPA, 1979), In re Lindner 173 USPQ 356 (CCPA 1972), In re Hyson, 172 USPQ 399 (CCPA 1972), In re Boesch, 205 USPQ 215, (CCPA 1980), In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983), In re Clemens, 206 USPQ 289 (CCPA 1980). It should be clear that the probative value of the data is not commensurate in scope with the degree of protection sought by the claim.

Therefore the rejection is deemed proper and it is adhered to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/
Primary Examiner
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